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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,079	03/20/2001	Tsutomu Takahashi	FUJI 18.486	1390

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EXAMINER

VU, PHUONG T

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,079

Applicant(s)

TAKAHASHI ET AL.

Examiner

Phuong T. Vu

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 and 15 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims 9-11,15 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claim 8 is unclear regarding the positive recitation of the subrack unit in the claim structure. The claim language is ambiguous, though it appears that it is Applicant's intent to only functionally recite the subrack.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 5,949,646). Regarding claim 12, the reference discloses a known communication device 8 (see figure 1) comprising a subrack unit 10 inherently comprising a back wiring board having connectors and first and second guide rail parts being attached to a top side and a lower portion of said subrack unit respectively, a plurality of plug-in units 12, 14 being inserted along the first and second guide rail parts into said subrack unit to be plugged into the connectors of the subrack unit, a member defined by the housing forming an air reservoir room 26 formed under the second guide rail parts, and a plurality of motor-fan units 16-20 each having a motor fan, said motor fan units being detachably plugged into said subrack unit under said member for forming the air reservoir room so that the motor-fan units and said member for forming an air reservoir room are sealably integrated with each other in the enclosure 8. Each component provided in enclosure is sealably integrated into the enclosure.

6. Claim 8 is rejected under 35 U.S.C. 102(e) as anticipated by Glover (US 6,242,690 B1). The reference discloses a plug-in unit 10 to be mounted in a subrack unit, the plug-in unit comprising a printed board 12 which is to be connected with the subrack, a metal case comprising 14, 16 including top and bottom faces, and parallel first and second side faces perpendicular to the top and bottom faces so as to cover said printed board, and first and second spring members 22, 36 for elastically pressing outward the first and second side faces of the metal case, respectively. The reference shows that the first and second spring members press outwardly and therefore would inherently be capable of pressing outwardly against ribs of the subrack unit by resilient

force thereof when the plug-in unit is mounted in such a subrack. It is noted that the recitation that an element is "adapted to", "for, or "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 5,949,646) as applied to claim 12 above, and further in view of Komai (US 6,291,766 B1). Regarding claim 14, the Lee reference does not teach providing a filler plug-in unit having the same size and resistance to airflow as each of the plug-in units, where the filler plug-in unit fills an open space left in the subrack unit. However, Komai (in discussion of fig. 9) teaches that it is known in the art to provide such filler plug-in units. The Komai reference is relied upon solely for this teaching. It would have been obvious to those skilled in the art at the time the invention was made that to provide filler plug-in units as shown in Komai to fill in open spaces in the subrack unit for electromagnetic shielding purposes.

Allowable Subject Matter

9. Claims 1-7 are allowed.

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10. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 12/12/02 have been fully considered but they are not persuasive. Regarding claim 12, the motor-fan units may be considered to be detachably plugged into the subrack unit as Lee teaches that the motor-fan units are commercially available units which are placed in the fan trays. Regarding the newly added claim language "so that the motor-fan units and said member for forming an air reservoir room are sealably integrated with each other", it may be broadly considered that each component provided in the computer enclosure is sealably integrated in the computer enclosure. The motor-fan unit and the member for forming the air reservoir room are adjacent parts of the computer enclosure and may be considered to be sealably integrated with each other in the computer enclosure as a whole. Therefore, the Lee reference meets limitations of the claim.

Regarding claim 8, as noted above, the scope of the claim regarding the presence of the subrack is indefinite and confusing. It appears that the subrack is not a part of claimed structure as function language is used in conjunction with the subrack. The claim appears to only positively recite a plug-in unit comprising a printed board, a metal case including top and bottom faces, parallel first and second side faces perpendicular to the top and bottom faces so as to cover said printed board, and first and second spring members for elastically pressing outward the first and second side

faces of the metal case, respectively. The Glover reference shows a plug-in which meets these limitations. In his arguments, Applicant states that the spring members "press outward first and second side faces of the metal cases against ribs in the sub-rack unit". As mentioned above, it appears that the subrack unit is not positively recited in the claim. Furthermore, it is noted more accurately that claim language associated with phrase states that the spring members are "for elastically pressing...against ribs of the sub-rack unit by resilient force...". The recitation that an element is "adapted to", "for, or "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Thus, it is only functionally recited that the spring members are for elastically pressing outward the first and second side faces of the metal against ribs of a subrack unit. The reference teaches providing first and second spring members which press outwardly and therefore would inherently be capable of pressing outwardly against ribs of the subrack unit by resilient force thereof when the plug-in unit is mounted in such a subrack. Applicant cannot claim details of the subrack or how the plug-in unit presses against parts of the subrack when it is not clear that said subrack is even positively claimed. Finally, Applicant states that Glover teaches that the spring members are provided to shield the perimeters of EMI-generating areas on the circuit board. While this is true, whether or not the spring members are for emi purposes is inconsequential, as the spring members still elastically press the first and second side faces of the metal cased outwardly and would therefore for inherently perform the recited function.

Conclusion


12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Vu whose telephone number is (703) 308-0303. The examiner can normally be reached on Mon. & Tues., 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (703) 308-3121. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


1/7/07



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